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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/749,282 | 12/31/2003 | Frederick R. Ernest | 25389A | 9791 |

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OWENS CORNING
2790 COLUMBUS ROAD
GRANVILLE, OH 43023

| EXAMINER | |
|---|---|
| KATCHEVES, BASIL S | |
| **ART UNIT** | **PAPER NUMBER** |
| 3635 | |

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/749,282 | ERNEST ET AL. | |
| | Examiner | Art Unit | |
| | Basil Katcheves | 3635 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *21 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *8-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 14-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/2806*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

Applicant has amended the claims in the amendment dated 7/21/06. Claims 8-13 are withdrawn, claims 1-7 and 14-20 are pending and examined below.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,910,280 to Robbins III.**

Regarding claim 14, Robbins discloses a corner molding (figs. 8 & 9) comprising separate pieces made of an extruded polymer (column 1, line 68 – column 2, line 14), the pieces having friction fit flanges (figs. 8 & 9: 36 & 38) for slidably receiving adjacent pieces. Applicant should note that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production, in this case, extrusion. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,354,057 to Ploplis in view of U.S. Patent No. 4,910,280 to Robbins, III.**

Regarding claims 1, 6 and 7, Ploplis teaches a corner finishing trim having first and second thermoplastic pieces (Figure 11), the first and second polymer pieces are then shown in Figure 1 to be welded together (column 6, line 65) to form an angle.

The polymer pieces can be made from polyvinyl chloride (PVC) (column 1, line 12). It should be noted that claim 7 is considered a product-by-process claim, therefore, determination of patentability is based on the product itself. See MPEP 2 113. The patentability of the product does not depend on its method of production. If ,the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different

process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Since Ploplis teaches pieces welded together, it is considered to read on the claims. Ploplis does not disclose the molding trim as having flanges for slidably engaging adjacent pieces. Robbins discloses corner molding (figs. 8 & 9) having flanges (36 & 38) slidably engaged to adjacent pieces. It would have been obvious to one having ordinary skill in

the art at the time the invention was made to modify Ploplis by adding the engaging means disclosed by Robbins, in order to better secure the molding pieces together.

**Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ploplis ('057) in view of Robbins III ('280) further in view of Enlow et al. (US Pat.Publication 2002/0157772).**

Regarding claims 2-5, Ploplis in view of Robbins teaches an assembly as stated above, but does not include a laminate of foil, UV protective wood grain foil, or white foil. Enlow teaches that it is known in the art to provide a protective and decorative surface film of various lnminates on polymeric (PVC and others) materials and panels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a coating of lnminate to a trim panel or assembly in various decorative colors or wood grains, as a matter of design choice. Often the trim in homes is white or wood grain, so this would allow for a material that has strength, is resistant to water and sunlight, and eliminates the need for painting or staining.

**Claims 15-18, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,910,280 to Robbins III in view of U.S. Patent Publication 2002/0157772 to Enlow.**

Robbins discloses a corner assembly as stated above, but does not include a laminate of foil, UV protective wood grain foil, or white foil. Enlow teaches that it is known in the art to provide a protective and decorative surface film of various laminates

on polymeric (PVC and others) materials and panels. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a coating of laminate to a trim panel or assembly in various decorative colors or wood grains, as a matter of design choice. Most often the trim found in peoples homes or offices is white or wood grain, so this would allow for a material that has strength, is resistant to water and sunlight, and eliminates the need for painting or staining.

**Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,910,280 to Robbins III.**

Regarding claim 19, Robbins discloses the use of any suitable polymeric material which may be thermoplastic or thermosetting (column 2, lines 10-15). Therefore it would have been an obvious design choice to use one of the polymer materials such as specified in these claims.

**Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,910,280 to Robbins III in view of U.S. Patent No. 6,354,057 to Ploplis.**

Regarding claim 20, Robbins does not disclose the use of welding the tri pieces together. Ploplis discloses the use of welding trim pieces. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Robbins by using welds, as disclosed by Ploplis, in order to create a water tight connection between members.

***Response to Arguments***

Applicant's arguments filed 7/21/06 have been fully considered but are moot under new grounds of rejections necessitated by the applicant's amendment.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack, can be reached at (571) 272-6848.

BK

9/6/06

Basil Katcheves

Primary Examiner, AU 3635